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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/155,842	04/06/2001	William James Brennan	CI5023A1	9223

23906 7590 09/11/2002

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EXAMINER

NGUYEN, KIMBERLY T

ART UNIT PAPER NUMBER

1774

DATE MAILED: 09/11/2002

✓

Please find below and/or attached an Office communication concerning this application or proceeding.

TC-12

<b>Office Action Summary</b>	Application No. 09/155,842	Applicant(s) BRENNAN ET AL.	
	Examiner Kimberly T. Nguyen	Art Unit 1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 8-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-10 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
     If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☒ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☒ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
     a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                 | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____   |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)        | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-7, drawn to a multilayer card.

Group II, claim(s) 8-10, drawn to a method of producing a multilayer card.

The inventions listed as Groups I-II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a special technical relationship among those inventions involving one or more of the same corresponding technical features which define a contribution over prior art. The special technical feature of the present invention—the multilayer card comprising an opaque polyester film substrate, ink-receptive layers, and cover layer—does not define a contribution over the prior art, as is revealed by Vanmaele et al., U.S. Pat. No. 5,753,352. Consequently, a lack of unity of invention exists. *See* 37 CFR 1.475 and MPEP 1850.

During a telephone conversation with Andrew G. Golian on June 17, 2002 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-7. Affirmation of this election must be made by applicant in replying to this Office action. Claims 8-10 are

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withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claim 1** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, it is not clear if the multilayer card comprises more than one ink-receptive layer since claim 1 shows "an ink-receptive layer" which is "on at least one surface of the substrate."

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-2 and 4-6** are rejected under 35 U.S.C. 103(a) as being unpatentable over Vanmaele et al., U.S. Pat. No. 5,753,352 in further in view of Kuze et al., U.S. Pat. No. 4,454,312.

Vanmaele shows a security document comprising an opaque polyester support, ink-receptive information carrier layer, and a covering element comprising an inner and outer laminating element (ink-receptive layer and cover layer, respectively) (Abstract). Vanmaele further shows that the support comprises titanium dioxide particles and polyesters, polyethylene naphthalate, and/or polyethylene terephthalate (column 4, lines 46-67). Vanmaele shows that the inner laminating element (ink-receptive layer) comprises acrylic or polyester resins (column 2, lines 60-64 and column 3, lines 28-58).

Vanmaele does not specifically show that the support comprises at least one copolyesterether (claim 1) such as an alkylene terephthalate (claim 2). Kuze shows a polyester film which is excellent in its physical properties comprising polyethylene terephthalate, alkylene terephthalate, and/or ethylene terephthalate (column 2, lines 31-51). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use alkylene terephthalate in the support of Vanmaele because it is known in the art that alkylene terephthalate is excellent for use as a mechanically strong support for films, packing materials, photographic films, and other laminates. Further, alkylene terephthalate and polyethylene terephthalate are functional equivalents as shown in Vanmaele and Kuze.

Vanmaele does not show the percentage by weight of the at least one copolyesterether as in instant claim 1 nor the percentage by weight of the titanium dioxide filler as in instant claim 4. However, such percentages is a property which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the percentages of weight, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order

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to optimize operation conditions (e.g. percentages of weight) fails to render claims patentable in the absence of unexpected results. All of the aforementioned limitations are result effective as they control the opacity, slipping property, mechanical strength, heat, chemical and weathering resistance of the film. As such, they are optimizable. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the security document of Vanmaele with the limitations of the percentages by weight of filler and copolyesterethers since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

**Claims 3-6** are rejected under 35 U.S.C. 103(a) as being unpatentable over Vanmaele et al., U.S. Pat. No. 5,753,352 in further in view of Parker, U.S. Pat. No. 3,793,029.

Vanmaele is relied upon as above for claims 1 and 4-6. Vanmaele does not show that the support comprises at least one poly(alkylene oxide) glycol as in instant claim 3.

Parker shows an opaque photographic film support comprising polyethylene glycols such as alkylene oxide polymers and polyglycols (column 5, lines 36-65). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the security document of Vanmaele with the polyglycols of Parker because it is known that such a copolyesterether provides mechanical strength and flexibility to film supports.

Vanmaele does not show the percentage by weight of the at least one copolyesterether as in instant claim 1 nor the percentage by weight of the titanium dioxide filler as in instant claim 4. However, such percentages is a property which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the percentages of weight, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are

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merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. percentages of weight) fails to render claims patentable in the absence of unexpected results. All of the aforementioned limitations are result effective as they control the opacity, slipping property, mechanical strength, heat, chemical and weathering resistance of the film. As such, they are optimizable. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the security document of Vanmaele with the limitations of the percentages by weight of filler and copolyesterethers since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

**Claim 7** is rejected under 35 U.S.C. 103(a) as being unpatentable over Vanmaele et al., U.S. Pat. No. 5,753,352 in further in view of Kuze et al., U.S. Pat. No. 4,454,312 and in further view of Parker, U.S. Pat. No. 3,793,029.

Vanmaele, Kuze, and Parker are relied upon as above for claims 1-6.

Vanmaele does not show that the laminating elements (ink-receptive layers) are present on both sides of the support as in instant claim 7. However, absent any evidence from the contrary, it is obvious to provide ink-receptive coatings on both sides of a support, motivated by the desire of providing ink-receiving properties to both sides (i.e., to enable the printing of both sides of the medium).

Vanmaele does not show the percentage by weight of the at least one copolyesterether as in instant claim 1 nor the percentage by weight of the titanium dioxide filler as in instant claim 4. However, such percentages is a property which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the percentages of weight, absent a showing of

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unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. percentages of weight) fails to render claims patentable in the absence of unexpected results. All of the aforementioned limitations are result effective as they control the opacity, slipping property, mechanical strength, heat, chemical and weathering resistance of the film. As such, they are optimizable. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the security document of Vanmaele with the limitations of the percentages by weight of filler and copolyesterethers since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly T. Nguyen whose telephone number is (703) 308-8176. The examiner can normally be reached on Monday to Friday, except on every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

CYNTHIA H. KELLY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700

